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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,577	01/15/2002	James J. Davies	CHA920010007US1	4673
23550	7590	12/07/2004	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC 3 E-COMM SQUARE ALBANY, NY 12207			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER

3629

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/047,577

Applicant(s)

DAVIES ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

The amendment filed 9/14/2004 has been entered.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-3 are directed to a method and program product for “determining conflicting tasks of business process”, which is not within one of the classes of invention set forth in § 101.

The method and program product for “determining conflicting tasks of business process” comprising the steps of:

- “(a) dividing the business .... ,
- (b) identifying for each of the component ... ,
- (c ) establishing at least one of ... , and
- (d) determining which of the at least one .....

as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

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The method and program product for “determining conflicting tasks of business process” comprising the steps of (a)-(d) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (failing to show manipulation/calculation of input data by computer or computing network or computing means to produce a separate/different result) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

### ***Response to Arguments***

3. Applicant's arguments filed 9/14/2004 have been fully considered but they are not persuasive. Applicant's responses, 2<sup>nd</sup> and 3<sup>rd</sup>, on page 6 have are not persuasive because it's not clear the relationship of “electronic signals and data representative of the business process” to the body of the claims since there is no discussion of the “.. signals.. data. .” in the body of the claim. There is no “assigning tasks” since this phrase is written in a passive state or “establishing at least one assigned component task performed by each person”. Furthermore, the last step of “determining whether each assigned component task is a conflicting task” is more like a question and answer response and not a clear transformation/manipulation of data into a different state or matter.

***Claim Rejections - 35 USC § 112***

4. Claims 1-3, 4-6, 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1:

1) It's not clear what is the scope of the claimed invention. If it's "determining conflicting tasks of business process", it could have been completed with the 2<sup>nd</sup> step of "identifying .. conflicts with the component task". It appears that the scope of the invention deals with "conflicting assignment of task to employee" due to predetermined conflicting task component. The focus should be on assignment of task component to each person involved in the business process.

2) it's not clear the relationship of "electronic signals and data representative of the business process" to the body of the claims since there is no discussion of the ".. signals.. data. ." in the body of the claim.

3) Claim 1, 2<sup>nd</sup> step recites the limitation "... with the component task". There is insufficient antecedent basis for this limitation in the claim. It appears that there is a 2<sup>nd</sup> dividing step of "dividing the component tasks into component task".

4) Claim 1 recites the limitation "one assigned component task" in "(c ) establishing..". There is insufficient antecedent basis for this limitation in the claim. Moreover, this step is vague and confused because it's written in inactive/passive state.

5) The last step "determining .... Other component tasks" is vague because it's not clear how this step is carried out by or by using what means.

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As in dep. claim 3 (part of 1), it's not clear the relationship between these tree new steps to the claimed invention.

Independent apparatus Claim 4 is vague and indefinite for the same reasons (5) set forth in claim 1 above.

Independent computer program product Claim 7 is vague and indefinite for the same reasons (5) set forth in claim 1 above.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

#### **I. US:**

1. US 2002/012 0482 by the same assignee for separations of duties analysis tool.

#### **2. NPL:**

1. Article "Affective organizational commitment of salespeople" An expanded model is cited for the teaching of indirect effects through role conflicts (see page 11) (date: Spring of 1993)

2. Article "Segregation ...throughout the enterprise" fairly teaches the automated assessment tool enables internal auditors to enhance (SOD) control reviews throughout the enterprise. (date: Oct, 2003).

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113


Or <http://pair-direct@uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov) .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
November 29, 2004

  
DEAN T. NGUYEN  
PRIMARY EXAMINER